

REMARKS/ARGUMENTS

The Examiner is requiring restriction to one of the following groups:

Group I:        Claims 1-11, drawn to compound of formula I and compositions thereof;  
                         and

Group II:        Claims 12-13, drawn to process of making compounds of formula I.

Applicants elect, with traverse, Group I, Claims 1-11, for examination.

In addition, the Examiner is requiring an election of species. Applicants provisionally elect with traverse, for examination purposes only, the species:

N-(4-(3-chloro-5-trifluoromethyl-2-pyridyloxy)-2-fluorophenyl)-2-fluoro-5-nitrothiobenzamide

wherein A is C-NO<sub>2</sub>; Hal is a fluorine atom; M<sup>1</sup> is a phenylene group substituted with a fluorine atom; M<sup>2</sup> is an oxygen atom, R<sup>6</sup>'s are a chlorine atom and a trifluoromethyl group; Cy is a pyridyl group; k = p = q = 0; and r = 2.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Examiner alleges a lack of unity of invention under PCT Rule 13.1 because, under PCT Rule 13.2, a "special technical feature" is lacking. The Examiner's rationale is: "In the instant inventions, the only structural element shared by groups I-II are compounds of formula I. However, compounds of formula I are well known. See GB 1512194 or US 5,977,410.

Therefore, under PCT Rule 13.1 and 13.2, compounds of formula I do not constitute a corresponding special technical feature among the groups.”

However, Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states (with emphasis added):

The expression “special technical feature” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, ***considered as a whole***, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

Applicants respectfully submit that the Examiner did not consider the contribution of the invention, ***as a whole***, over the disclosure of the cited reference. Applicants also respectfully submit that the Examiner has not provided any indication that the contents of the claims interpreted in light of the description was considered in making the assertion of a lack of unity. Therefore, the Examiner has not met the burden necessary to support the assertion of a lack of unity of the invention.

In regard to the election of species, Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP § 808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the requirement for election is improper, and Applicants’ election of species is for examination purposes only.

Applicants submit that the Examiner has not shown that an examination of all of the present claims can be made without serious burden placed on the Examiner. Applicants further submit that the Examiner has failed to meet the burden necessary in order to sustain the restriction and election requirement. Therefore, Applicants request that the restriction and the election requirement be withdrawn and that all of the present claims be examined on the merits.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

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